

REMARKS

In the Office Action dated February 26, 2004, claims 1-22 were presented for examination. Claims 1-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Tsutsumi et al.* in view of *Singhal et al.*

Applicants wish to thank the Examiner for the careful and thorough review and action on the merits in this application.

I. 35 U.S.C. §103(a) - Obviousness over *Tsutsumi et al.* in view of *Singhal*

In the Office Action of February 26, 2004, the Examiner assigned to the application rejected claims 1-22 under 35 U.S.C. §103(a) as being unpatentable over *Tsutsumi et al.*, U.S. Patent No. 5,812,998, in view of *Singhal*, U.S. Patent No. 6,163,782.

The *Tsutsumi et al.* patent ('998) relates to a database and a method of conducting a database search. One or more sub-databases are organized according to a database search. Results of the search are stored in a search result database. When a subsequent search is conducted, the degree of similarity with a previous search stored in the search result database is calculated. The degree of similarity is based upon data produced from a query. This calculation decreases the search time for a subsequent search.

The *Singhal* patent ('782) relates to a distributed information management system comprised of a plurality of databases (150). Each database separately performs indexing of data information contained within that database using search queries. See Col. 5, lines 47-49, and Col. 6, line 49. A global index is created by deriving statistical information from the index of each database in a collection of databases. When a search is conducted, the global index is consulted to improve searching efficiency.

In reviewing and studying the prior art references of *Tsutsumi et al.* and *Singhal*, it is clear that the scope of these two prior patents and Applicant's claimed invention are divergent in nature. Both the *Tsutsumi et al.* and *Singhal* patents specifically apply to database and database

structures, wherein queries are implemented to leverage data. A database is a collection of information organized into interrelated tables of data and specifications of data objects in such a way that a computer program can quickly select desired pieces of data. "Traditional databases are organized by fields, records, and files. A field is a single piece of information; a record is one complete set of fields; and a file is a collection of records."¹ The process of requesting information from a database is known as a query.² However, Applicant's invention does not apply to a database or database structure. Rather, Applicant's invention pertains to a library, which is defined in the application as "a list of names", see page 4, line 14, wherein a name is defined as an "alphanumeric string", see page 4, line 8. It is accepted that "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." MPEP §2143.03-(citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)). There still remains no teaching, suggestion, or motivation in either *Tsutsumi et al.* or *Singhal* to expand their database structure to a library, as taught and claimed by Applicant. Applicant's library is not a database or an equivalent storage structure. Both *Tsutsumi et al.* and *Singhal* are limited to a database structure and do not teach or suggest the library structure as claimed by Applicant. Furthermore, Applicant does not teach or suggest the process of conducting a query of their library, as Applicant's library is not a database. Accordingly, the subject matter of Applicant's invention is divergent from the database environment of both *Tsutsumi et al.* and *Singhal*.

As the CAFC has made clear, the prior art must teach the desirability of the modification. "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Gordon et al.*, 733 F.2d 900, 221 USPQ 1125, 1127 (Fed. Cir. 1984). It is axiomatic that the subject matter of the claims may not be considered obvious as a result of a hypothetical combination of references unless something in the references suggests that an advantage may be derived from combining

¹ Definition of "Database," available in Webopedia Computer Dictionary, www.webopedia.com, June 27, 2003. Attached as Exhibit A.

² Definition of "Query," available in Webopedia Computer Dictionary, www.webopedia.com, March 25, 2003. Attached as Exhibit B.

their teachings. In this respect, the CAFC appears to speak directly to the issue of the need to determine the scope and contents of the prior art, and the source of motivation for combining the references. Accordingly, the determination as to what may be within the scope and contents of the prior art serves to establish the parameters of what art may even be considered in determining the obviousness of an invention.

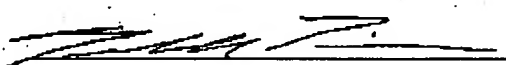
The Examiner utilizes *Tsutsumi et al.* to teach the limitations associated with Applicant's support for determining proximity within a master library. However, as stated above, *Tsutsumi et al.* is limited by its use to a database environment, and specifically to determining proximity between sub-databases of a database. In this way, *Tsutsumi et al.* fails to account for Applicant's use of a determining proximity control system in association with a library. "Although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.'" MPEP §2143.01 (citing *In re Mills*, 916 F.2d 680, 682, 16 USPQ 2d 1430 (Fed. Cir. 1990)). "Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant's disclosure." *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). Similarly, *Singhal* teaches creating a global index of a collection of database by use of a query not a library. *Singhal* is limited to the subject matter of a database and the process of using a query of the database to conduct a proximity calculation. In fact, both *Tsutsumi et al.* and *Singhal* teach away from the modification suggested by the Examiner. *Singhal* does not suggest modifying the database system to include a library, as defined by Applicant. There is no suggestion found in *Tsutsumi et al.* for a modification to apply the proximity determination from a database environment to a library. Furthermore, there is no teaching or suggestion in either *Tsutsumi et al.* or *Singhal* to use a data leveraging technique of their database with something other than a query. The only suggestion for a system that utilizes a proximity determination applied to a library environment is derived from Applicant's invention. Absent Applicant's invention, there is no suggestion or motivation within the combination of *Tsutsumi et al.* and *Singhal* for such a modification. "It is impermissible to use the claimed invention as an instructions manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ 2d 1780 (Fed. Cir. 1992) (citing *In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991)). Yet this is the very process that the Examiner has

attempted to undertake. The combination of the prior art references is improper as the Examiner's combination is precipitated by utilizing Applicant's claimed invention as the template to make the modifications suggested by the Examiner. Accordingly, the Applicants respectfully submits that claims 1-22 would not have been obvious in view of *Tsutsumi et al.* ('998) in view of *Singhal* ('782) and respectfully requests removal of the rejection.

In light of the foregoing amendments and remarks, all of the claims now presented are in condition for allowance, and Applicants respectfully request that the outstanding rejections be withdrawn and this application be passed to issue.

The Examiner is urged to call the undersigned at the number listed below if, in the Examiner's opinion, such a phone conference would aid in furthering the prosecution of this application.

Respectfully submitted,



Rochelle Lieberman
Registration No. 39,276
Attorney for Applicants

Lieberman & Brandsdorfer, LLC
12221 McDonald Chapel Drive
Gaithersburg, MD 20878
Phone: (301) 948-7775
Fax: (301) 948-7774
email: rocky@legalplanner.com

Date: June 28, 2004